

REMARKS

This paper is presented in response to the final official action dated April 10, 2009, and advisory action dated June 22, 2009, wherein (a) claims 1-3, 5-13, and 15-20 were pending, (b) claims 1, 2, 5, 9, 10, 13, and 17-20 were rejected as obvious over Hiroshi et al JP 10-059364 ("Hiroshi") in view of Boersma U.S. 2003/0052038 A1 ("Boersma"), (c) claims 3, 11, and 12 were rejected over Hiroshi in view of Boersma and further in view of applicant's alleged admitted prior art, (d) claim 6 was rejected as obvious over Hiroshi in view of Boersma and further in view of Rose U.S. 6,119,929 ("Rose"), (e) claims 7, 8, 15, and 16 were rejected as obvious over Hiroshi in view of Boersma and further in view of Lochmiller U.S. 4,383,609 ("Lochmiller"), and (f) claims 2, 3, 11, and 12 were rejected as obvious over Hiroshi in view of Boersma and further in view of Barnes et al. U.S. 3,968,895 ("Barnes").

By the foregoing, claim 1 is amended and claim 21 is new. Support for the amendment to claim 1 and new claim 21 may be found in the specification and claims as originally filed. For example, support for the amendment to claim 1 and new claim 21 may be found at least in original claim 1, Figs. 2 and 3, at page 6, lines 5-12, and at page 6, line 19 to page 7, line 5 of the specification as originally filed. No new matter is added.

As a result of the foregoing, claims 1-3, 5-8, 10-12, 15-17, 19-21 are pending.

Reconsideration of the application, as amended, is solicited.

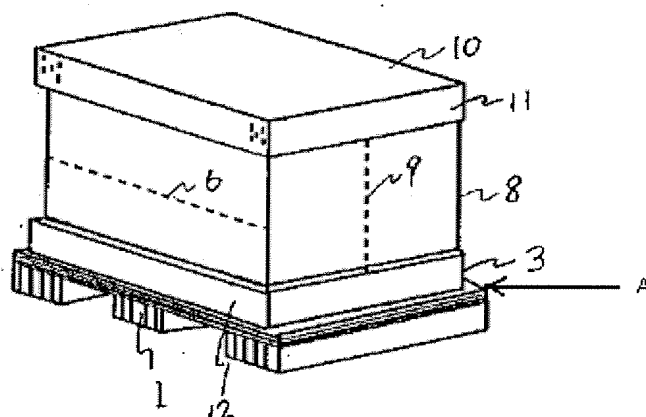
This paper is timely filed.

A request for continued examination (RCE) and the required fee is enclosed herewith. The RCE is proper according to 37 CFR 1.114 in that the RCE is filed before a decision on appeal and the RCE should be treated as a request to withdraw the appeal and to reopen prosecution of the application. This paper includes a submission under 37 CFR 1.114 in the form of the forgoing amendments and the following remarks.

Applicants respectfully request that the Board of Patent Appeals and Interferences be advised of the filing of this RCE. See M.P.E.P. § 706.07(h)(X).

According to the advisory action, the examiner appears to read the previous claims as not requiring an item to be placed on the pallet within a storage area of the container. Thus, the examiner asserts Hiroshi discloses a container in Fig. 1 reproduced below (arrow "A" is added to Fig. 1 for discussion), which would allow an item to be placed directly on the edge of the pallet (in the vicinity of arrow "A") outside the body 8 of the assembly box.

【図1】



Amended claim 1 clarifies the invention and overcomes the examiner's previous interpretation of the claims as being broad enough to encompass Hiroshi. Claim 1 now recites a storage area defined by sidewalls of a container, the storage area being disposed immediately adjacent the planar top of the pallet. In other words, the storage area is not separated from the planar top of the pallet by any other element, and an item may be placed within the storage area and directly on the top of the pallet. The prior art fails to disclose or suggest a storage area of a container that is disposed immediately adjacent the planar top of the pallet.

Applicants respectfully traverse the rejection of claims 1-3, 5-13, and 15-20 as obvious over Hiroshi in view of any one of Boersma, Rose, Lochmiller, and Barnes. As discussed in the amendment filed June 9, 2009, Hiroshi discloses an assembly

box for powdery materials, grain materials, short-fibrous materials, etc., that can be easily contained and easily discharged. See Hiroshi, abstract. The assembly box includes a square cylindrical body 8, a lower tray 3 as a bottom, positioned at the lower part of the body 8, and a pallet 1 under the lower tray 3. *Id.*, see Fig. 1 of Hiroshi reproduced above.

As clearly seen in Fig. 1, and as taught by Hiroshi, the tray 3 is solid and the tray 3 is placed between the body 8 and the pallet 1. This teaching makes sense in light of the intended use of the Hiroshi device to transport fine granular materials that would otherwise be lost without the solid tray 3. As a result of the solid tray 3 being placed between the body 8 and the pallet 1, any storage area within the body 8 cannot be disposed immediately adjacent a top of the pallet, as is recited in each of the pending claims.

Boersma, Rose, Lochmiller, and Barnes all fail to disclose or suggest a container including at least three sidewalls having an open base and a pallet, wherein the top of the pallet forms a base of the sidewalls, a storage area being disposed immediately adjacent a top of a pallet, nor were Boersma, Rose, Lochmiller, and Barnes cited as disclosing such limitations. To the contrary, each of Boersma, Rose, Lochmiller, and Barnes discloses a container having a solid bottom, which would not allow a storage area to be disposed immediately adjacent a top of a pallet.

Because Hiroshi, Boersma, Rose, Lochmiller, and Barnes all fail to disclose or suggest a storage area disposed immediately adjacent a top of a pallet, none of the pending claims can be rendered obvious by any combination of Hiroshi, Boersma, Rose, Lochmiller, and Barnes. For this reason, Applicants respectfully request withdrawal of the rejections and allowance of the pending claims.

Additionally, one of ordinary skill in the art would not modify Hiroshi to include a storage area disposed immediately adjacent a top of a pallet because doing so would render the Hiroshi device unsuitable for its intended purpose. "If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); See also M.P.E.P. § 2143.01(V). As stated in the abstract, the purpose of the Hiroshi box is to transport “powdery materials, granular materials, short-fibrous materials, etc.” Such materials require a solid bottom surface to prevent some or all of the material from being lost through gaps or holes. As is known in the art, typical transportation pallets have several wood planks forming an upper support surface. These wood planks are often separated by a distance to reduce the weight of the pallet and to reduce the amount of material required to build the pallet. As a result, at least some transportation pallets do not have solid support surfaces. If the Hiroshi box were modified to include sidewalls having a storage area disposed immediately adjacent a top of a pallet (as recited in the pending claims), granular material would be lost between the planks of the pallet, thus rendering the Hiroshi box unsuitable for its intended purpose. For this reason, one skilled in the art would not modify the Hiroshi box to include an open base.

Moreover, transporting fine granular materials requires a sealed or continuous connection between the sidewalls and the base to prevent fine granular material from being lost between the sidewalls and the base. Modifying the Hiroshi box to include a storage area disposed immediately adjacent a top of a pallet would require removal of the tray 3. Removal of the tray 3 would remove the containment system for the fine granular material. As a result, the fine granular material would seep between the side walls and the pallet, thus rendering the Hiroshi box unsuitable for its intended purpose. For this additional reason, one skilled in the art would not modify the Hiroshi box to include an open base.

The claimed container produces advantages over the cited art. For example, the claimed container reduces the risk of the container slipping during transportation. See the instant application at page 6, lines 24-25. Containers having a base generally are subject to slipping when carrying heavy objects because the base lowers friction between the container and the top of the pallet. Cardboard containers are especially prone to such slippage. The claimed container, on the other hand, allows an item to be placed within the storage area and directly on the top of the pallet. The friction created between the item and the pallet is generally higher than

the friction between a container base and the pallet. As a result, the claimed container reduces slippage during shipping.

Additionally, the claimed container is safer for personnel when the container is used to ship heavy items. See the instant application at page 7, lines 1-5. When picking up a container with an unknown object, personnel can easily injure muscles in the back, or even damage a spinal disc, if the object in the container is heavier than expected. The claimed container prevents such injuries because when personnel grasp the container, the container simply lifts off of the pallet, leaving the heavy object on the pallet.

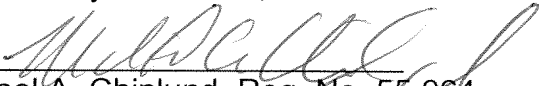
Conclusion

For all the foregoing reasons, it is submitted that all pending claims are of proper form and scope for allowance, and such action is solicited.

Should the examiner wish to discuss the foregoing or any matter of form in an effort to advance this application toward allowance, he is urged to telephone the undersigned at the indicated number.

September 16, 2009

Respectfully submitted,

By 
Michael A. Chinlund, Reg. No. 55,064
MARSHALL, GERSTEIN & BORUN LLP
6300 Willis Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300
Agent for Applicant